

Serial No. 09/782,539

Amend. In Resp. to Off. Act. of July 22, 2004

UTILITY PATENT

B&D No. TN-1379A

REMARKS

Applicants have amended Claims 25. Claims 25-26 and 30-32 are therefore pending in the present application.

The Examiner rejected Claims 25-26 and 30-32 under 35 USC § 103(a) as being unpatentable over US Patent No. 5,903,462 ("Wagner"). Reconsideration and withdrawal of this rejection is respectfully requested.

Claim 25, as amended, calls for a power tool system comprising a power tool including a first memory for storing use profile information about the power tool, a reader apparatus connectable to the power tool for downloading the stored use profile information from the first memory, the reader apparatus comprising a second memory for storing the stored use profile information downloaded from the first memory, and a computer separate from the reader apparatus and connectable to the reader apparatus for downloading the downloaded information from the second memory of the reader apparatus, the computer comprising a third memory for storing the downloaded information from the second memory.

Admittedly, Wagner discloses a power tool with a memory for storing use profile information, and a computer with a memory for downloading such information. However, Wagner does not disclose a reader apparatus separate from the computer for downloading the information from the power tool and later sending it to the computer. Indeed, the Board of Appeals noted in its decision in the present case that "Wagner does not specifically address such a configuration."

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By contradistinction, Claim 25 requires "a reader apparatus connectable to the power tool for downloading the stored use profile information from the first memory, the reader apparatus comprising a second memory for storing the stored use profile information downloaded from the first memory, and a computer separate from the reader apparatus and connectable to the reader apparatus for downloading the downloaded information from the second memory of the reader apparatus." Such arrangement is critical as it allows a person to obtain the store information at the construction jobsite without bringing fragile computers to hook up to the power tool.

The Examiner has argued that it would be obvious to "make separable the reader and the computer in order to provide an on-site user with an input device cable of sensing stored information, and of conveying that information into on-line storage." However, such modification would change Wagner's principle of operation.

According to the CCPA, if the proposed modification of the prior art changes the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In Wagner, the stored information is directly obtained and analyzed by the computer connected to the power tool, rendering the need for an additional reader apparatus superfluous. Since the reader apparatus is superfluous, adding a reader apparatus to Wagner would change the principle of obtaining and analyzing information. Accordingly, suggestion exists to modify Wagner

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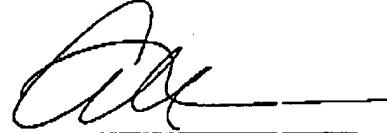
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as proposed by the Examiner. Therefore, Wagner cannot render Claims 25-26 and 30-32 unpatentable.

All the claims are patentable and the application is believed to be in condition for formal allowance. Reconsideration of the application and allowance of Claims 25-26 and 30-32 are respectfully requested.

No fee is due for the present amendment. Nevertheless, the Commissioner is authorized to charge payment of any fees due in processing this response, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



Adan Ayala, Reg. No. 38,373
Attorney for Applicants
(410) 716-2368